

REMARKS

In the Office Action¹ mailed November 26, 2007, the following actions were taken:

1) claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102(a) as being anticipated by US Pub. No. 2003/0046281, by Son (hereinafter "*Son*");

2) claims 2-16, 18-32 and 34-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* and further in view of US Pat. No 5,222,234, by Wang (hereinafter "*Wang*").

Claims 1, 6-14, 17, 22-30, 33, 47-48, and 50-51 are amended. Claims 1-54 are pending in the application, of which claims 1, 17, 33 are independent.

Standard for Rejections under 35 U.S.C. 102(b)

In the Office Action, claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102(a) as being anticipated by *Son*. To properly establish that a prior art reference anticipates a claimed invention under 102, each and every element of the claims in issue must be found, whether expressly described or under principles of inherency, in the single prior art reference.

For an Office Action to make out a prima facie case of inherent disclosure, "the missing descriptive matter is necessarily present in the thing described in the reference." See M.P.E.P. § 2112 (IV), quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." See *id.*, quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Rejections under 35 U.S.C. 102(b)

Applicant respectfully traverses the rejection of claims 1, 17, 33 and 46-54 since *Son* fails to teach each and every element of these claims. For example, *Son* does not disclose at least the following elements found in amended claim 1:

- “**selecting a system location** in which the selected at least one resource is to be reserved,” and
- “executing, in response to the user’s selection, a command to **preserve the content** of the selected at least one resource **in the system location**” (the emphasis added).

While the Office Action did not address the first element, namely the “selecting” element because it has been newly added to claim 1, the Office Action addresses an earlier version of the second element. The Office Action cites several sections of *Son* to show that the command to preserve content is inherent in *Son*. Specifically, the Office Action cites para. 0101, with the assertion that “the intermediate server determines that the first search history was used when content was selected and therefore executes the step of rewarding the registrant of the first search history”, to show that preserving content is inherent in *Son*. See Office Action page 9. However, as stated above, in order to rely upon inherency, the Examiner must show that the quoted elements are necessary. Applicant respectfully points out that this was not shown. Moreover, nowhere in this citation is there a suggestion of **preserving the content** of the selected resource **in the system location**.

Applicant respectfully points out that *Son*’s para. 0101 does not refer to selecting a system location in which the resource is to be reserved or preserving the content of the resource in the system location as disclosed in claim 1. In *Son*, the user selects content directly from the search results and issues a request to get the content. However, *Son* is silent on selecting a system location and preserving the content of the

selected resource in the system location. The operation of the content retrieval process is explained in more detail in *Son's* para. 0094,

When the first user selects desired content out of his or her search results presented on the window shown in Fig. 10 and issues a request for retrieval of the content (S7), the intermediate server 3 sends to the central server 1 a request for retrieval of the content on behalf of the user (S8). The central server 1 authenticates the intermediate server 3 and distributes the content to the intermediate server 3 (S9). The intermediate server 3 transfers the retrieved content to the user terminal 2 of the first user (S10) and charges the first user for the content (S11).

Therefore, in *Son*, the content from the content database in the central server is transferred to the user terminal, but no further steps are disclosed. *Son* does not disclose any information regarding the preservation of the content or the selection of a system location in which the resources are to be preserved if preserved at all. Certainly, in *Son*, the user can only view the content when the content is transferred to the user terminal. "Selection of a system location" and "preservation" are not necessary when the content is transferred to the user terminal. Moreover, the content of the selected resource are not preserved anywhere else in *Son's* system, because the information stored in the storage of the intermediate server in *Son* only includes indexes, user authentication data and user-specific search history. See *Son* at para. 0045. Therefore, nowhere in *Son* is there a suggestion that the storage or the user terminal includes the content of the selected resource.

In the Office Action, *Son's* para. 0058 and 0060 are cited for also showing that preserving content is inherent in *Son*. Para. 0058 states, "When the intermediate server presents search results to the user, the user is asked whether or not the search results should be recorded as search history." Para. 0060 states, "In this preferred embodiment, after executing a search, the intermediate server prompts the user to input comments which are recorded as a part of the history record of the search. This step is intended to collect information reflecting the actual circumstances of user search request activity." See Office Action at 10. However, nowhere in this embodiment, is

there a suggestion of preserving the **content of the selected resources** or selecting a system location in which the content can be preserved. *Son*'s search history records do not contain content of the selected resources. See *Son* at para. 0063. "Each search history record includes data on the subject of the search and the state of the search results (the number of "hits" of searched content titles) with the embedded link to further information for the record. When the viewer clicks the hypertext link, further information of the record is displayed, such as the registrant name as the key, the contact to the registrant, the specified conditions of the search, search results, time when the search was executed, evaluation and comments." See *Son* at para. 0063 and Fig. 3.

Therefore, nowhere in *Son*'s para. 0058, 0060 and 0101 or elsewhere in *Son*, is there a suggestion for "selecting a system location in which the selected at least one resource is to be reserved," and "executing, in response to the user's selection, a command to preserve the content of the selected at least one resource in the system location" as recited in claim 1. As such, the cited portions of *Son* cannot teach or suggest the elements recited in claim 1.

For at least these reasons, claim 1 is allowable under 35 U.S.C. §102. For at least the reasons stated above with respect to claim 1, claims 17 and 33 are allowable at least since they recite similar elements and were rejected under the same rationale as claim 1. See Office Action at page 2. Moreover, claims 46-54 are allowable since they depend directly or indirectly from claims 1, 17 and 33.

For these reasons, Applicant's claims are patentably distinct from *Son*. Applicant respectfully requests the rejection under 35 U.S.C. §102 of independent claims 1, 17, 33 and claims 46-54 which depend therefrom, to be withdrawn.

Rejection of the Claims under 35 U.S.C. §103

Applicant respectfully traverses the rejection of claims 2-16, 18-32 and 34-45 under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Wang*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claims 2-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Wang* and the Office Action contains the assertion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Son* to include teachings of *Wang*. Applicant respectfully disagrees and traverses the rejection for at least the reasons stated below.

Claims 2-16 depend from claim 1, and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, *Son* fails to teach, disclose or suggest the features recited in claim 1, and required by claims 2-16, namely, “selecting a system location in which the selected at least one resource is to be reserved,” and “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in the system location.” The Office Action cited *Wang*, in combination or alone with *Son*, as teaching features recited in claims 2-16, but not recited in claim 1. See Office Action at page 3-7. Even assuming the Office Action’s assertion is correct, *Wang* fails to cure the deficiencies of *Son* discussed above. That is, *Wang* also fails to teach, disclose or suggest, “selecting a system location in which the selected at least one resource is to be reserved,” and “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in the system location,” as recited in claim 1 and required in claims 2-16.

In addition, the burden is on the Patent Office to provide some tenable rationale as to *why* one of ordinary skill in the art would combine *Son* and *Wang* so as to arrive at the presently claimed methods recited in claims 2 - 16. In the present case, however, no such rationale has been provided.

Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.”) (emphasis is added). Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would combine *Son* and *Wang*.

Applicant made a similar argument in its response to the Office Action mailed August 2, 2007, the first Action in which the § 103(a) rejection under *Son* and *Wang* was made. In the Final Action mailed November 26, 2007 that was issued subsequently, the Examiner asserted, “The reason for combination is clearly stated in

above Office Action.” See Office Action at 11. However, Applicant respectfully submits that no such reason for combination is articulated in either the Office Action mailed August 2, 2007 or the instant Office Action mailed November 26, 2007.

The only statements about the combination of *Son* and *Wang* in the Office Actions appear on pages 3 - 7 and 11 of the Office Action mailed November 26, 2007 and pages 3 - 7 of the Office Action mailed August 2, 2007. In both, for claim 2, the Office Action merely contains the assertion, “It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Son* to include [the folder feature recited in claim 2] for the purpose of saving similar content in an easily accessible memory location.” See Office Actions at 3. For claims 3 - 16, both Office Actions merely contain an assertion, “The combination of *Son* and *Wang* discloses the elements of the claimed invention as noted above and, furthermore, discloses [the feature recited in the claim].” However, these assertions do not demonstrated *why* or *how* one would modify *Son*’s system with *Wang*’s features so as to arrive at the claimed invention.

At best, the Office Action’s position could be considered an assertion that the proposed modifications could be performed. However, “[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art suggests the desirability of the combination.” M.P.E.P. § 2143.01 (emphasis in original).

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claims 2-16 are obvious under § 103(a). Therefore the § 103(a) rejection of claims 2 -16 is improper, and should be withdrawn.

For at least the reasons noted above, claims 18-32 and 34-45, which recite similar elements and were rejected under the same rationale, are allowable under 35 U.S.C. 103(a). See Office Action at page 3-7.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this

Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: Maura K. Moran

Maura K. Moran
Reg. No. 31,859